

REMARKS

Introduction

Claims 19-37 are pending in this application. Claims 19, 30, 31, 33 and 36 have been amended. In view of the forgoing amendments and following remarks, it is respectfully submitted that claims 19-37 are allowable, and reconsideration is respectfully requested.

Double Patenting Rejection

Claims 19-37 have been provisionally rejected as unpatentable over co-pending Application No. 10/540,419. Such a rejection does not require filing of a Terminal Disclaimer or other response unless the claims of the cited applications actually issue, and the double patenting rejection remains as the sole remaining rejection in this application. Applicants thank the Examiner for the notification, and will respond further to this rejection when the rejection is no longer provisional.

Rejection of Claims 19-30, 36 and 37 under 35 U.S.C. § 101

Claims 1-25, 27 and 28 (of which claims 1-18 are canceled) have been listed by the Examiner as being rejected under 35 U.S.C. § 101. However, the Examiner discusses only claims 19-30, 36 and 37 in the detailed discussion of the rejection. For the purposes of responding to this rejection, Applicants assume the Examiner intended to reference claims 19-30, 36 and 37.

While Applicants do not agree with the rejection, to facilitate matters, claim 16 has been amended to recite, “at least one of electronically encoding with **an encoding device**, decoding with **a decoding device** and transmitting an electronic data packet with **a transmitting device**, the data packet containing location information of at least one object for a map.” Claim 30 has been amended to recite, “at **at least one of an encoding device, a decoding device and a transmitting device**, providing an electronic data packet including location information of at least one object for a map.” Claim 36 has been amended to recite, “an arrangement to electronically transmit an electronic data packet using **a transmitting device**.”

It is respectfully submitted that the recitation of encoding, decoding and transmitting **devices** is sufficient to relate the claimed subject matter to physical apparatus. As to the Examiner's contention that the claimed subject matter is not sufficiently transformative, it is respectfully submitted that the steps of encoding, decoding, and transmitting are **inherently transformative**, since data is either converted or transported.

For at least the foregoing reasons, Applicants submit that claims 19, 30 and 36, as well as dependent claims 20-29 and 37, are in compliance with 35 U.S.C. § 101.

Rejection of Claims 19-37 under 35 U.S.C. § 102(e)

Claims 19-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,438,561 ("Israni"). It is respectfully submitted that the claims 19-37 are not anticipated by Israni for at least the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 19 recites, in relevant parts, "transmitting **an electronic data packet** using a transmitting device, the data packet **containing location information** of at least one object **for a map, the location information** of at least one object **including locating information**

and description information, wherein the data packet separately contains the locating information and the description information, and includes assignment information assigning at least a part of the locating information to at least a part of the description information.” Claims 30, 31, 33 and 36 recite substantially similar limitations as the above-recited limitations of claim 19.

As presented, claim 19 provides that the data packet includes locating information, description information and assignment information. The assignment information assigns at least a part of the locating information to at least a part of the description information.

The Examiner contends that the traffic message (col. 5, lines 15-60), location component (col. 5, lines 33-35), and event description component (col. 5, lines 28-31) of Israni are respectively analogous to the data packet, locating information and description information of claim 19. The Examiner then asserts that col. 5, lines 54-60; col. 13, lines 35-45; and col. 14, lines 5-11 disclose assignment information assigning at least a part of the locating information to at least a part of the description information. However, the cited portions merely describe a location table number “assigned to each separate location table” (col. 5, lines 54-60); “assign[ing] specific reference codes to locations in the geographic region about which the traffic messages relate” (col. 13, lines 35-45); and “location numbers . . . assigned by the road authorities” (col. 14, lines 5-11). It is obvious by example that the cited portions of Israni simply **do not** describe the assigning of the location component to the event description component. This is clear from the fact that none of the cited portions of Israni relates to an assignment of information contained in the data packet to further information contained in the same packet. At most, Israni merely teaches the use of different types of identifiers, e.g., for location tables and physical locations, which teaching is clearly insufficient to disclose or even suggest the claimed assignment information as provided for in claims 19, 30, 31, 33 and 36.

Accordingly, claims 19, 30, 31, 33 and 36, as well as their dependent claims 20-29, 32, 34, 35 and 37, are allowable over Israni.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 19-37 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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